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**FAX TRANSMISSION**

DATE: November 1, 2006

PTO IDENTIFIER: Application Number 10/619,773-Conf. #8782  
Patent Number

Inventor: James W. Hodges

MESSAGE TO: US Patent and Trademark Office

FAX NUMBER: (571) 273-8300

FROM: RADER, FISHMAN &amp; GRAUER PLLC

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Attorney Dkt. #: 60680-1802

PAGES (Including Cover Sheet): 27

CONTENTS: Fee Transmittal (1 page)  
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Application No. (if known): 10/619,773

Attorney Docket No.: 60680-1802

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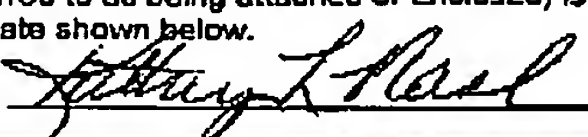
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TRANSMITTAL OF APPEAL BRIEF			Docket No. 60680-1802
In re Application of: James W. Hodges			
Application No. 10/619,773-Conf. #8782	Filing Date July 15, 2003	Examiner A. K. Pickard	Group Art Unit 3673
Invention: GASKET HAVING AN INNER EDGE WITH COINED ANGLES AND METHOD OF MANUFACTURE			
<b><u>TO THE COMMISSIONER OF PATENTS:</u></b>			
Transmitted herewith is the Appeal Brief in this application, with respect to the Notice of Appeal filed: <u>September 1, 2006</u>			
The fee for filing this Appeal Brief is <u>\$ 500.00</u>			
<input checked="" type="checkbox"/> Large Entity <input type="checkbox"/> Small Entity			
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<input checked="" type="checkbox"/> The Director is hereby authorized to charge any additional fees that may be required or credit any overpayment to Deposit Account No. <u>18-0013</u> This sheet is submitted in duplicate.			
 Kristin L. Murphy Attorney Reg. No. : 41,212 RADER, FISHMAN & GRAUER PLLC 39533 Woodward Avenue Suite 140 Bloomfield Hills, Michigan 48304 (248) 594-0647		Dated: <u>November 1, 2006</u>	
<b>Appeal Brief Transmittal</b>			
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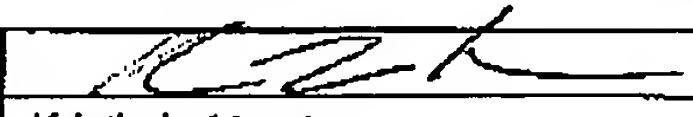
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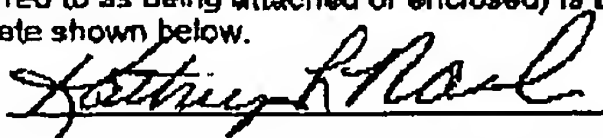
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Effective on 12/08/2004. Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818). <b>FEE TRANSMITTAL</b> <b>For FY 2006</b>		<b>Complete if Known</b> Application Number 10/619,773-Conf. #8782 Filing Date July 15, 2003 First Named Inventor James W. Hodges Examiner Name A. K. Pickard Art Unit 3673 Attorney Docket No. 60680-1802	
<input type="checkbox"/> Applicant claims small entity status. See 37 CFR 1.27			
<b>TOTAL AMOUNT OF PAYMENT</b> (\$) 500.00			

<b>METHOD OF PAYMENT (check all that apply)</b> <input type="checkbox"/> Check <input type="checkbox"/> Credit Card <input type="checkbox"/> Money Order <input type="checkbox"/> None <input type="checkbox"/> Other (please identify): _____ <input checked="" type="checkbox"/> Deposit Account Deposit Account Number: 18-0013 Deposit Account Name: Rader, Fishman & Grauer PLLC For the above-identified deposit account, the Director is hereby authorized to: (check all that apply) <input checked="" type="checkbox"/> Charge fee(s) indicated below <input type="checkbox"/> Charge fee(s) indicated below, except for the filing fee <input checked="" type="checkbox"/> Charge any additional fee(s) or underpayments of fee(s) under 37 CFR 1.16 and 1.17 <input checked="" type="checkbox"/> Credit any overpayments	
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<b>FEE CALCULATION</b> <b>1. BASIC FILING, SEARCH, AND EXAMINATION FEES</b>							
Application Type	FILING FEES		SEARCH FEES		EXAMINATION FEES		Fees Paid (\$)
	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	
Utility	300	150	500	250	200	100	
Design	200	100	100	50	130	65	
Plant	200	100	300	150	160	80	
Reissue	300	150	500	250	600	300	
Provisional	200	100	0	0	0	0	
<b>2. EXCESS CLAIM FEES</b>							
						Fee (\$)	Small Entity Fee (\$)
Each claim over 20 (including Reissues)						50	25
Each independent claim over 3 (including Reissues)						200	100
Multiple dependent claims						360	180
<u>Total Claims</u>		<u>Extra Claims</u>	<u>Fee (\$)</u>	<u>Fee Paid (\$)</u>	<u>Multiple Dependent Claims</u>		
- =		x	=		<u>Fee (\$)</u>		<u>Fee Paid (\$)</u>
HP = highest number of total claims paid for, if greater than 20.							
<u>Indep. Claims</u>		<u>Extra Claims</u>	<u>Fee (\$)</u>	<u>Fee Paid (\$)</u>			
- =		x	=				
HP = highest number of independent claims paid for, if greater than 3.							
<b>3. APPLICATION SIZE FEE</b> If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)), the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).							
<u>Total Sheets</u>	<u>Extra Sheets</u>	<u>Number of each additional 50 or fraction thereof</u>	<u>Fee (\$)</u>	<u>Fee Paid (\$)</u>			
- 100 =	/50	(round up to a whole number) x	=				
<b>4. OTHER FEE(S)</b>							
Non-English Specification, \$130 fee (no small entity discount)							
Other (e.g., late filing surcharge): 1402 Filing a brief in support of an appeal							500.00

<b>SUBMITTED BY</b> Signature  Registration No. 41,212 Telephone (248) 594-0647 Name (Print/Type) Kristin L. Murphy Date November 1, 2006			
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Dated: 11/1/06Signature: Kathryn L. Nash

(Kathryn L. Nash)

Docket No.: 60680-1802  
(PATENT)**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of:  
James W. Hodges

Application No.: 10/619,773

Confirmation No.: 8782

Filed: July 15, 2003

Art Unit: 3673

For: GASKET HAVING AN INNER EDGE WITH  
COINED ANGLES AND METHOD OF  
MANUFACTURE

Examiner: A. K. Pickard

**APPEAL BRIEF**

MS Appeal Brief - Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

This appeal is from the decision of the Primary Examiner dated September 3, 2006 ("Final Office Action"), finally rejecting claims 1, 3-10 and 12-19, which are reproduced as an Appendix to this brief. The Notice of Appeal was filed on September 1, 2006. This application was filed on July 15, 2003.

As required under § 41.37(a), this brief is filed within two months of the Notice of Appeal filed in this case on September 1, 2006, and is in furtherance of said Notice of Appeal.

The fees required under § 41.20(b)(2) are dealt with in the accompanying  
TRANSMITTAL OF APPEAL BRIEF.

This brief contains the headings as required by 37 C.F.R. § 41.37 and M.P.E.P. § 1206.

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NOV 01 2006

Application No.: 10/619,773

Docket No.: 60680-1802

TABLE OF CONTENTS

I. REAL PARTY IN INTEREST .....	PAGE 3
II. RELATED APPEALS AND INTERFERENCES.....	PAGE 4
III. STATUS OF CLAIMS .....	PAGE 5
IV. STATUS OF AMENDMENTS.....	PAGE 6
V. SUMMARY OF CLAIMED SUBJECT MATTER.....	PAGE 7
VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL.....	PAGE 9
VII. ARGUMENT.....	PAGE 10
VIII. CONCLUSION.....	PAGE 17
IX. CLAIMS APPENDIX.....	PAGE 18
X. EVIDENCE APPENDIX.....	PAGE 22
XI. RELATED PROCEEDINGS APPENDIX .....	PAGE 23

NOV 01 2006

Application No.: 10/619,773

Docket No.: 60680-1802

I. REAL PARTY IN INTEREST

The Real Party-In-Interest is Dana Corporation, located at 4500 Dorr Street, P.O. Box 1000, Toledo, Ohio 43697.

NOV 01 2006

Application No.: 10/619,773

Docket No.: 60680-1802

II. RELATED APPEALS, INTERFERENCES, AND JUDICIAL PROCEEDINGS

There are no other appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.



Application No.: 10/619,773

Docket No.: 60680-1802

### III. STATUS OF CLAIMS

Claims 1-11 were originally filed, new claims 12-19 were added during prosecution. Claims 2 and 11 are canceled. Claims 1, 3-10 and 12-19 are pending, and are the subject of this appeal.

Claims 1, 3-10, 13 and 14 under consideration stand rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over U.S. Patent 4,300,773 to Jelinek ("Jelinek") in view of U.S. Patent 5,322,299 to Terai ("Terai").

Claims 1, 3, 4, 6-10 and 12-19 under consideration stand rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Jelinek in view of U.S. Patent No. 6,719,300 to Fujino et al. ("Fujino") in view of Terai.

Claims 1, 3-7, 9, 12, 13, 15-17 and 19 under consideration stand rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Fujino in view of Terai.

Application No.: 10/619,773

Docket No.: 60680-1802

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#### IV. STATUS OF AMENDMENTS

In connection with filing a Request for Continued Examination, on July 7, 2005, Applicant submitted an amendment to claims 1, 10 and 12. These amendments were entered by Examiner Pickard. While Applicant received a non-final office action on January 12, 2006 and a final office action on July 3, 2006, Applicant did not make any additional amendments to the claims in response to either of these office actions.

NOV 01 2006

Application No.: 10/619,773

Docket No.: 60680-1802

## V. SUMMARY OF CLAIMED SUBJECT MATTER

The presently claimed invention is directed to a gasket for an internal combustion engine having an inner edge with coined angles to increase the surface area of the gasket that is exposed to an elastomeric material. The following is a concise explanation of the subject matter defined in each of the independent claims involved in the appeal, as required by 37 C.F.R. § 41.37(c)(1)(v). However, in general, the following explanation is not intended to be used to construe the claims, which are believed to speak for themselves, nor do Appellants intend the following explanation to modify or add any claim elements, or to constitute a disclaimer of any equivalents to which the claims would otherwise be entitled, nor is any discussion of certain preferred embodiments herein intended to disclaim other possible embodiments. References herein to the Specification are intended to be exemplary and not limiting.

## A. Claim 1

Claim 1 recites a gasket that comprises a base sheet of substantially contiguous metal material having at least one aperture bounded by an edge of the base sheet. Specification, page 3, paragraph [0012]. One or more coined angles are formed at the edge of the base sheet. Specification, page 3, paragraph [0013]. An elastomeric material is disposed on the one or more coined angles and the edge of the base sheet. Specification, page 4, paragraph [0014]. The coined angles increase a surface area of the base sheet that is exposed to the elastomeric material, thereby increasing bonding strength between the base sheet and the elastomeric material. Specification, page 4, paragraph [0015]. This is in contrast to conventional gaskets which only have elastomeric material to be disposed at the edge of the gasket, thereby producing a weak bond between the elastomeric material and the base sheet of the gasket. Specification, page 4, paragraph [0015]. Further, one or more of the coined angles also includes a textured surface to further increase the bonding strength between the base sheet and the elastomeric material. Specification, page 4, paragraph [0016].

**NOV 01 2006**

Application No.: 10/619,773

Docket No.: 60680-1802

**B. Claim 10**

Claim 10 recites a method for manufacturing a gasket. The method comprises forming one or more coined angles at an edge of a base sheet of substantially contiguous metal material. Specification, page 4, paragraph [0017]. A texture is then applied to an outer surface of one or more of the coined angles. Specification, page 5, paragraph [0017]. An elastomeric material is disposed on the one or more coined angles and on the edge of the base sheet. Specification, page 5, paragraph [0017]. This method increases the surface area of the base sheet that is exposed to the elastomeric material, thereby increasing the bonding strength between the base sheet and the elastomeric material. Specification, page 5, paragraph [0017].

**C. Claim 12**

Claim 12 recites a gasket that comprises a base sheet of substantially contiguous metal material having at least one aperture bounded by an edge of the base sheet. Specification, page 3, paragraph [0012]. One or more coined angles are formed at the edge of the base sheet. Specification, page 3, paragraph [0013]. The coined angles are defined by a gradual reduction in thickness toward the edge of the base sheet. Specification, page 4, paragraph [0016]. An elastomeric material is disposed on the one or more coined angles and the edge of the base sheet. Specification, page 4, paragraph [0014]. The coined angles increase a surface area of the base sheet that is exposed to the elastomeric material, thereby increasing bonding strength between the base sheet and the elastomeric material. Specification, page 4, paragraph [0015]. This is in contrast to conventional gaskets which only have elastomeric material to be disposed at the edge of the gasket, thereby producing a weak bond between the elastomeric material and the base sheet of the gasket. Specification, page 4, paragraph [0015].

Further, one or more of the coined angles also includes a textured surface to further increase the bonding strength between the base sheet and the elastomeric material. Specification, page 4, paragraph [0016].

NOV 01 2006

Application No.: 10/619,773

Docket No.: 60680-1802

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

- A. Whether claims 1, 3-10, 13 and 14 are unpatentable under 35 U.S.C. §103(a) over Jelinek in view of Terai.
- B. Whether claims 1, 3, 4, 6-10 and 12-19 are unpatentable under 35 U.S.C. §103(a) over Jelinek in view of Fujino in view of Terai.
- C. Whether claims 1, 3-7, 9, 12, 13, 15-17 and 19 are unpatentable under 35 U.S.C. §103(a) over Fujino in view of Terai.

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Docket No.: 60680-1802

Application No.: 10/619,773

## VII. ARGUMENT

The Examiner's rejections should be reversed. The pending 35 U.S.C. §103(a) rejections are improper as there is no motivation to combine the various references and because the Examiner has simply used Applicant's claims as a blueprint for piecing together elements in the prior art to substantiate the rejections. For these reasons, as explained in further detail below, all of the pending claim rejections should be reversed.

## A. Summary of the Applicable Law

MPEP § 2143 sets forth the basic requirements for the Patent and Trademark Office to establish *prima facie* obviousness as follows:

To establish a *prima facie* case of obviousness, three criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

*See also In re Linter*, 458 F.2d 1013, 173 USPQ 560, 562 (CCPA 1972). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990), *W.L. Gore and Associates, Inc. v. Garlock, Inc.* 220 USPQ 303 (Fed. Cir. 1966). Moreover, the fact that the claimed invention is within the capabilities of one of ordinary skill in the art is not sufficient by itself to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993).

*In re Oetiker* further provides that "[t]here must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination." *In re Oetiker*, 977 F.2d 1443, 1447 (Fed. Cir. 1992). "The Examiner must show reasons that the skilled artisan, confronted with the same problem as the inventor and with no

Application No.: 10/619,773

Docket No.: 60680-1802

knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.” *In re Rouffet*, 47 USPQ2d 1453, at 1458 (Fed. Cir. 1998) (emphasis added).

As established by Federal Circuit precedent, to establish a *prima facie* case of obviousness, the Examiner must provide some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. *See, e.g., Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985) (“To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the Examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references”); *In re Geiger*, 815 F.2d 686, 688, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987) (“When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references”); *ACS Hosp. Sys. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984) (“Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination”); *accord*. MPEP § 2143.

It is established law that one “cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.” *Ecolchem, Inc. v. Southern Cal. Edison Co.*, 227 F.3d 1361, 1371, 56 USPQ2d 1065 (Fed. Cir. 2000) (citing *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1780, 1783 (Fed. Cir. 1988)). Indeed, “[c]ombining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor’s disclosure as a blueprint for piecing together the prior art to defeat patentability – the essence of hindsight.” *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Moreover, “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).



Application No.: 10/619,773

Docket No.: 60680-1802

**B. Claims 1, 3-10, 13 and 14 Are Allowable over the Jelinek and Terai Combination  
(Ground of Rejection A)**

1. Independent Claims 1 and 10 are patentable over the Combination of Jelinek and Terai

It is well established that the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the applicant's disclosure." *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Further, as stated in *Akzo N.V. v. United States Int'l Trade Comm'n*, 1 USPQ 2d 1241 (Fed. Cir. 1986), prior art references must be read as a whole.

In making the rejection of claims 1, 3-10, 13 and 14, the Examiner has combined Jelinek with Terai, stating that it would have been obvious for one of ordinary skill in the art at the time the invention was made to apply a texture to coined angles of a base sheet in a gasket to improve adhesion of the elastomer. However, the Examiner has not provided any motivation to combine these references. In fact, the *only* motivation to combine the references appears to come from the Applicant's claims, and not the prior art cited.

Jelinek, the primary reference, teaches a seal 10 having a backing plate 12 that is stamped out of flat sheet metal. One or more apertures 14 may be punched into the backing plate during the stamping process. After stamping, the aperture 14 is coined forming a lip 20 around the periphery of the aperture 14. A layer of elastomeric material 22 is then bonded to the lip. The elastomeric material layer 22 includes a main section 24 that is compressed between an end cap 36 and a housing 38. (Jelinek, 3:27-32; FIG. 4). The seal 10 further includes a spacer portion 26 that extends from the main section 24 of the elastomeric material 22 that bindingly contacts a "highly finished grip surface 50" of the end cap 36 with an interference fit. (Jelinek, 3:5-12). The grip surface 50 has a diameter that is slightly larger than the inner diameter of the spacer portion 26. Therefore, the seal 20 taught in Jelinek is bindingly restricted on all sides and will not move within the encased location between the end cap 36 and the housing 38, thereby eliminating any concern for the adhesion strength of the elastomeric material 22.

The Examiner admits that Jelinek does not teach a textured surface as required by claims 1, 3-10, 13 and 14. Indeed, as set forth above, Jelinek was not concerned with adhesion strength of



Application No.: 10/619,773

Docket No.: 60680-1802

the elastomeric material, as the material was encapsulated between the end cap and the housing. Instead, to make up for the admitted deficiencies of Jelinek, the Examiner simply points to Terai, which teaches roughened surfaces that are formed on portions of the top and bottom surfaces of the base 10 of the gasket, simply stating "it would have been obvious for one of ordinary skill in the art at the time the invention was made to apply a texture to the coined angles of the base sheet . . ."

However, as there was no concern regarding increasing adhesion strength of the elastomer in Jelinek, and no need for such an increase given the structure of the seal and its positioning between the end cap and the spacer portion, there was simply no motivation or suggestion to look to Terai to provide increased adhesion as required by *In re Linter*. Indeed, the only motivation for this combination is in Applicant's disclosure. As such, the rejection is simply an example of improper hindsight and independent claims 1 and 10, as well as all those claims that depend therefrom, are patentable over the combination of Jelinek and Terai.

2. Claims 13 and 14 are separately patentable over the Jelinek and Terai combination.

In addition to the application of impermissible hindsight, outlined above, Claims 13 and 14, which depend upon claims 1 and 10, respectively, are both separately patentable over the combination of Jelinek and Terai. Claims 13 and 14 both require that the texture is applied to one or more coined angles, at least in part, by the addition of material.

First, there is simply no suggestion or motivation in Jelinek to add material to coined angles taught therein. Second, Terai does not teach adding material to provide a "textured surface" as required by claims 13 and 14. While the Examiner has cited the application of primer 41 that is taught in Terai as a teaching for a "textured surface," nowhere does Jelinek disclose that the primer 41 produces a textured surface. In fact, Figure 15(b) of Jelinek, which illustrates the primer 41, shows just the opposite. More specifically, the primer layer 41 is shown as having a smooth surface. Accordingly, Jelinek does not show that the primer 41 results in a "textured surface." Accordingly, claims 13 and 14 are separately patentable over the Jelinek and Terai combination.

Application No.: 10/619,773

Docket No.: 60680-1802

**C. Claims 1, 3, 4, 6-10 and 12-19 Are Allowable over the Jelinek, Fujino and Terai Combination (Ground of Rejection B)**

The Examiner again relies upon Jelinek as the primary reference, and Terai as teaching "textured surfaces." The analysis of the Jelinek reference above is equally applicable to this ground of rejection.

The Examiner admits that neither Jelinek, nor Terai teach coined angles that are defined by a gradual reduction in thickness toward the edge of the sheet. Instead, the Examiner relies upon Fujino as teaching "an art equivalent" of the lip of Jelinek, in an effort to support the substitution of Fujino with Jelinek.

First and foremost, Fujino cannot teach an art equivalent of the lip 20 of Jelinek since Fujino does not illustrate any portion of a metal gasket that has a lip such as the lip 20 of Jelinek with a sectioned profile that includes interior right angles. At best, Fujino illustrates, in FIGs. 3I-3III, three tapered parts of a metal gasket A. (Fujino, 3:35-43). Fujino certainly does not teach any advantage of the parts shown, discuss any differing adhesion capabilities thereof, or illustrate a lip, such as the lip of Jelinek. Indeed, Fujino is silent as to any lip with an interior right angle, such as the lip 20 of Jelinek, and cannot teach an "art equivalent" thereof.

Further, *In re Scott* provides that "[e]xpeditents which are functionally equivalent to each other are not necessarily obvious *in view of* one another." *In re Scott*, 139 USPQ 297, 299 (CCPA 1963), emphasis in original. Therefore, even assuming *arguendo*, that Fujino does teach an art equivalent (which Applicant maintains Fujino does not), the Examiner has failed to make a showing of obviousness by failing to provide any reasoned basis for why the tapered part of Fujino is obvious *in view of* the lip 20 of Jelinek, as required by *In re Scott*. As the Examiner has failed to provide any motivation for substituting the tapered parts of the metal gasket of Fujino with the teachings of Jelinek, the obviousness rejection cannot stand.

**D. Claims 1, 3-7, 9, 12, 13, 15-17 and 19 Are Allowable over the Fujino and Terai Combination (Ground of Rejection C)**

As discussed above, the Examiner has failed to provide any motivation for combining the metal base sheet of Fujino with the roughened surfaces of Terai to reject claims 1, 3-7, 9, 12, 13, 15-

Application No.: 10/619,773

Docket No.: 60680-1802

17 and 19. Instead, the Examiner has simply stated that the combination is appropriate because it is the Examiner's opinion that the combination "would improve adhesion of the elastomer applied."

As set forth above, no where does Fujino mention or even suggest that the edge of the metal base sheet "improves adhesion." Rather, Fujino states that the surfaces shown in FIGs. 3I-3III are presented to illustrate that the elastic seal member 7 may "be compressed up to the plate thickness of the metal gasket." (Fujino, 3:44-45).

Indeed, the focus of Fujino is quite different than the endeavor that the Applicant was concerned with. More specifically, Fujino was focused on pouring a liquid gasket 6 into interstitial spaces between mating surfaces. The elastic seal member 7 was provided to berm the liquid gasket 6 (see, e.g., FIG. 17). There is no disclosure that the seal member 7 is providing any sealing function during operation of the device of Fujino, as it is the liquid gasket 6 that provides the sealing function. (Fujino, 1:32-36).

Thus, one of ordinary skill in the art would not have been motivated to employ the teachings of Fujino in creating a seal with increased bonding strength for longer adhesion, as the seal member 7 is only needed temporarily until the liquid gasket 6 is inserted therein. Thus, there certainly is no motivation to combine Fujino and Terai as the device of Fujino would not benefit from increased adhesion between the elastic seal member 7 and the metal base sheet A.

Finally, despite the fact that it is well known "obvious to try is not the standard of 35 U.S.C. 103." *In re Antoine*, 195 USPQ 6, 8 (CCPA 1977), this is precisely what the Examiner appears to be doing by posing the rejection. Indeed, the Examiner has failed to point to any motivation in either of the references that establish a motivation or suggestion for the combination. Further, Terai appears to teach away from such a combination as Terai reveals that the roughened surfaces 21 are only applied to opposing parallel surfaces. There is simply no teaching or suggestion in either Terai or Fujino of a likelihood of success in increasing adhesion if the roughened surfaces 21 of Terai were provided on non-parallel surfaces of the tapered parts that define the outer edge of the metal base plate A of Fujino. Indeed, the likelihood of success of such a combination appears to have come

Application No.: 10/619,773

Docket No.: 60680-1802

from only one source – Applicant's own specification. Thus, the rejection is improper and should be overturned.

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NOV 01 2006

Docket No.: 60680-1802

Application No.: 10/619,773

## VIII. CONCLUSION

In view of the foregoing arguments, Appellant respectfully submits that the pending claims are novel over the cited references. The Examiner's rejections of all pending claims are improper because the prior art of record does not teach or suggest each and every element of the claimed invention. In view of the above analysis, a reversal of the rejections of record is respectfully requested of this Honorable Board.

It is believed that any fees associated with the filing of this paper are identified in an accompanying transmittal. However, if a fee is due, please charge our Deposit Account No. 18-0013, under Order No. 60680-1802 from which the undersigned is authorized to draw. To the extent necessary, a petition for extension of time under 37 C.F.R. 1.136(a) is hereby made, the fee for which should be charged against the aforementioned account.

Dated: Nov. 1, 2006

Respectfully submitted,

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Docket No.: 60680-1802

Application No.: 10/619,773

**IX. CLAIMS APPENDIX**

Pursuant to 37 CFR § 41.37(c)(vii), the following listing provides a copy of the claims involved in the appeal. As indicated above, the claims do include the amendments filed by Applicant on July 7, 2005.

1. A gasket comprising:

a base sheet of substantially contiguous metal material having at least one aperture bounded by an edge of said base sheet;

one or more coined angles formed at said edge of said base sheet;

an elastomeric material disposed on said one or more coined angles and said edge of said base sheet; and

wherein said one or more coined angles increase a surface area of said base sheet exposed to said elastomeric material, thereby increasing bonding strength between said base sheet and said elastomeric material, and wherein said one or more coined angles includes a textured surface to further increase the bonding strength between said base sheet and said elastomeric material.

2. (Canceled)

3. A gasket according to Claim 1, wherein said elastomeric material disposed on said one or more coined angles forms a sealing bead.

4. A gasket according to Claim 1, wherein said base sheet is substantially thin.

5. A gasket according to Claim 4, wherein said base sheet has a thickness of approximately 1.0 mm.

Application No.: 10/619,773

Docket No.: 60680-1802

6. A gasket according to Claim 1, wherein said coined angles extend radially inwardly from said edge and are integrally joined to said base sheet.
7. A gasket according to Claim 1, wherein said base sheet is generally planar.
8. A gasket according to Claim 1, wherein said elastomeric material comprises silicone rubber.
9. A gasket according to Claim 1, wherein said coined angles are generally symmetric about an axis, A, of said base sheet.
10. A method of manufacturing a gasket comprising the steps of:
  - forming one or more coined angles at an edge of a base sheet of substantially contiguous metal material;
  - applying a texture to an outer surface of the one or more coined angles;
  - disposing an elastomeric material on the one or more coined angles and on the edge of the base sheet;
  - whereby the one or more coined angles increase a surface area of the base sheet exposed to the elastomeric material, thereby increasing bonding strength between the base sheet and the elastomeric material.
11. (Canceled)
12. A gasket comprising:
  - a base sheet of substantially contiguous metal material having at least one aperture bounded by an edge of said base sheet;
  - one or more coined angles formed at said edge of said base sheet, wherein said coined angles are defined by a gradual reduction in thickness toward said edge of said base sheet;
  - a textured surface applied to said one or more coined angles; and
  - an elastomeric material disposed on said one or more coined angles and said edge of said base sheet;



Application No.: 10/619,773

Docket No.: 60680-1802

wherein said coined angles wherein said one or more coined angles increase a surface area of said base sheet exposed to said elastomeric material, thereby increasing bonding strength between said base sheet and said elastomeric material.

13. The gasket of claim 1, wherein said textured surface is applied to said one or more coined angles, at least in part, by the addition of material.

14. The method of claim 10, wherein said texture is applied to said one or more coined angles, at least in part, by the addition of material.

15. The gasket of claim 12, wherein said textured surface is applied to said one or more coined angles, at least in part, by the addition of material.

16. The gasket of claim 1, wherein said one or more coined angle extends between said edge and a planar surface defined by said gasket, wherein said edge is generally orthogonal to said planar surface, and said textured surface is oriented at an angle of about 5 degrees to about 30 degrees to said planar surface.

17. The gasket of claim 16, wherein said textured surface is oriented at an angle of about 10 degrees to said planar surface.

18. The method of claim 10, wherein said one or more coined angle extends between said edge and a planar surface defined by said gasket, wherein said edge is generally orthogonal to said planar surface, and said step of applying a texture to an outer surface includes applying a texture to a surface that is oriented at an angle of about 5 degrees to about 30 degrees to said planar surface.

19. The gasket of claim 12, wherein said one or more coined angle extends between said edge and a planar surface defined by said gasket, wherein said



Application No.: 10/619,773

Docket No.: 60680-1802

edge is generally orthogonal to said planar surface, and said textured surface is oriented at an angle of about 5 degrees to about 30 degrees to said planar surface.

Application No.: 10/619,773

X. EVIDENCE APPENDIX

No evidence pursuant to §§ 1.130, 1.131, or 1.132 or entered by or relied upon by the examiner is being submitted.

**NOV 01 2006**

Application No.: 10/619,773

Docket No.: 60680-1802

**XI. RELATED PROCEEDINGS APPENDIX**

No related proceedings are referenced in II. above, or copies of decisions in related proceedings are not provided, hence no Appendix is included.